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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/819,400	03/28/2001	Tsutomu Kawano	01180/LH	3804

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EXAMINER

KIM, CHONG R

ART UNIT PAPER NUMBER

2623

DATE MAILED: 12/16/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/819,400

Applicant(s)

KAWANO, TSUTOMU

Examiner

Charles Kim

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 6-10 and 16-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-5 and 11-15 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 August 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) g.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. This application contains claims directed to the following patentably distinct species of the claimed invention:

Species A, claims 1-5, 11-15

Species B, claims 6-10, 16-20

2. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, no claims are generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to

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be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

3. During a telephone conversation with Robert Michael (Registration No. 35,614) on December 4, 2003, a provisional election was made without traverse to prosecute the invention of species A, claims 1-5, 11-15. Affirmation of this election must be made by applicant in replying to this Office action. Claims 6-10, 16-20 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Claim Objections

The following quotation of 37 CFR § 1.75(a) is the basis of objection:

(a) The specification must conclude with a claim particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention or discovery.

4. Claims 1-5, 11-15 are objected to under 37 CFR § 1.75(a) as failing to particularly point out and distinctly claim the subject matter which the applicant regards as his invention or discovery.

Referring to claim 1, there appears to be numerous logical inconsistencies in the claim language. For example, claim 1 recites a “display means for displaying a single or a plurality of image processing conditions” in lines 14-15, and an “image processing condition selecting means for selecting an arbitrary image processing condition from the image processing conditions displayed on the display means” in lines 16-18. It is unclear how an image processing condition can be arbitrarily selected from the display means if the display means displays a

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single image processing condition. For examination purposes, the phrase “display means for displaying a single or a plurality of image processing conditions” will be interpreted as “display means for displaying a plurality of image processing conditions”. There appears to be similar inconsistencies in the phrase “wherein the image processing condition selecting means reads out and displays one or a plurality of image processing conditions” in lines 23-24. It appears that the applicant intended the phrase to read “wherein the image processing condition selecting means reads out and displays a plurality of image processing conditions”. Appropriate correction is required.

Similar objections apply to claim 11.

Referring to claim 2, there appears to be logical inconsistencies in the claim language. For example, claim 2 recites “and the image processing means applies image processing to the radiation image and produces a processed image for each of the one or plurality of image processing conditions read out from the image processing condition memorizing means on the basis of the discrimination result of the discrimination means, and the image processing condition selecting means displays the processed images on the image display means together with the image processing conditions applied to the processed images respectively” in lines 3-12. It is unclear how the image processing condition selecting means displays a plurality of processed images if the image processing means produces a single processed image of one image processing condition read out from the image processing condition memorizing means.

Appropriate correction is required.

Similar objections apply to claim 12.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1-5, 11-15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Referring to claim 1, the phrase “accepts a selection of an arbitrary image processing condition from the displayed image processing conditions” in lines 27-29 renders the claim indefinite because it is unclear whether the “displayed processing conditions” are the processing conditions displayed on the display means (lines 14-15), or if they are the processing conditions displayed by the image processing condition selecting means. Furthermore, the phrase “display means for displaying a single or a plurality of image processing conditions” in lines 14-15, and the phrase “wherein the image processing condition selecting means reads out and displays one or a plurality of image processing conditions” in lines 23-25 further renders the claim indefinite because it is unclear whether the image processing conditions are displayed twice (once by the display means and once by the image processing condition selecting means), or if the image processing conditions are displayed once by the display means, wherein the display means is part of the image processing condition selecting means.

The rejection above is also applicable to claim 11.

Claims not mentioned specifically are dependent from indefinite antecedent claims.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-3, 5, 11-13, 15 are rejected under 35 U.S.C. 102(b) as being anticipated by Godlewski et al., U.S. Patent No. 5,270,530 (“Godlewski”).

Referring to claim 1 as best understood, Godlewski discloses an image processing apparatus, comprising:

a. radiation image forming means for detecting a radiation amount transmitted through an object and forming a radiation image corresponding to the detected amount (col. 3, lines 58-67 and col. 4, lines 16-21)

b. a discriminating means for discriminating at least one of a body part of the object and a radiographing orientation (position of patient) for a radiation image formed by the radiation image forming means (col. 4, lines 24-28)

c. image processing condition memorizing means for memorizing each of a plurality of image processing conditions corresponding to each of body parts of an object (col. 11, lines 37-40 and figures 27-28)

d. display means for displaying a plurality of image processing conditions (figure 14)

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e. image processing condition selecting means for selecting an arbitrary image processing condition from the image processing conditions displayed on the display means (col. 10, lines 52-58 and figure 14)

f. image processing means for applying image processing to a radiation image on the basis of the selected image processing condition (col. 10, lines 10-43)

g. wherein the image processing condition selecting means reads out and displays a plurality of image processing conditions on the basis of a discrimination result obtained by the discriminating means, and the image processing condition selecting means accepts a selection of an arbitrary image processing condition from the displayed image processing conditions (col. 10, lines 44-63 and figure 14).

Referring to claim 2 as best understood, the claims use of “or” between two limitations requires the prior art to meet either one of the limitations. In this case, Godlewski further discloses that the image processing condition selecting means comprises an image display means (figure 14), and the image processing means applies image processing to the radiation image and produces a processed image for one image processing condition read out from the image processing condition memorizing means on the basis of the discrimination result of the discrimination means (col. 10, lines 10-63), and the image processing condition selecting means displays the processed image on the image display means together with the image processing conditions applied to the processed image (figure 14. Note that the right portion of the screen in figure 14 displays the processed image and the left portion displays the image processing conditions).

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Referring to claim 3, Godlewski further discloses that the image processing condition selecting means displays an image process name to specify the image processing condition (figure 14).

Referring to claim 5, Godlewski further discloses that the image processing condition selecting means displays presence information of an image rotation (rotate right, rotate left) and presence information of image inversion (flip vertical, flip horizontal) with regard to the selected image processing condition (figure 13).

Referring to claim 11, see the rejection of at least claim 1 above.

Referring to claim 12, see the rejection of at least claim 2 above.

Referring to claim 13, see the rejection of at least claim 3 above.

Referring to claim 15, see the rejection of at least claim 5 above.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 4 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Godlewski et al., U.S. Patent No. 5,270,530 ("Godlewski").

Referring to claim 4, Godlewski fails to explicitly disclose that the image process name is indicated by a radiographed body part of an object. However, Godlewski explains that the

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radiographed body part of the object is displayed along with the image (figure 8). Godlewski further explains that the image processing is determined according to the body part of the object (col. 10, lines 44-45). Note that the image processing condition and the body part of the object are corresponding features. Therefore, it would have been obvious to modify the image process name so that it is indicated by a radiographed body part of an object. The ordinary artisan would have been motivated in order to provide the user with information representing the radiation image, and allow the user to verify examination information (col. 8, line 62-col. 9, line 5). Furthermore, the Examiner notes that the "image process name" is not considered a patentable feature, since it merely describes an image and the processing conditions associated with that image. Therefore, the specific "image process name" would have been arbitrarily chosen by a user during experimentation to meet his/her specific requirements.

Referring to claim 14, see the rejection of at least claim 4 above.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

a. Gaborski U.S. Patent No. 5,943,435 discloses an apparatus for body part recognition in radiographic images.

b. Takeda et al. U.S. Patent No. 5,345,513 discloses an apparatus for processing a radiation image, wherein the image processing conditions correspond to the body part of a patient.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles Kim whose telephone number is 703-306-4038. The examiner can normally be reached on Mon thru Thurs 8:30am to 6pm and alternating Fri 9:30am to 6pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Amelia Au can be reached on 703-308-6604. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-306-0377.



ck

December 9, 2003



Jon Chang
Primary Examiner